

REMARKS

A. Status of the Claims

1. Favorable reconsideration of this application as presently presented is respectfully requested. Claims 1, 2, 4, 6-20, 22-28, 63 and 64 are pending. In this Amendment, claims 1 and 64 are amended, and no claims are added or cancelled. Claims 3, 5, 21, and 29-62 have been cancelled by previous amendments. No new matter is added.

2. Support for the amendments to Claims 1 and 64 is found in the specification on page 51, lines 19-24, as well as the original specification, drawings and claims.

B. Section 102 Rejections.

Rejection of Claim 64 by McDonald are Obviated by the Amendments to the Claim.

3. Claim 64 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,564,803 to McDonald, *et al.* ("McDonald"). This rejection is respectfully obviated with respect to the claims as currently presented.

4. Claim 64 as currently presented recites a method of "putting a dispensing apparatus at a first location in a ready state based on said identification information" and "entering destination information about a second location where at least one serving is to be delivered to a customer, *wherein the second location is a different location than the first location in said readied dispensing apparatus* [at the first location]." (See Applicant's claim 64, emphasis added). As previously agreed to with the Examiner during the Examiner Interview of March 28, 2006, McDonald neither teaches nor suggests the claim feature of "entering destination information about a location of a recipient where at least one serving is to be delivered in said readied dispensing apparatus [at the first location]." However, the Final Office Action provided no reasons for the reversal of this previous agreement. Furthermore, the Final Office Action does not and cannot to cite any portion of McDonald for teaching "entering destination information about a second location where at

least one serving is to be delivered to a customer, wherein the second location is a different location than the first location in said readied dispensing apparatus [at the first location]" as claimed by Claim 64. Therefore, Claim 64 is patentable over McDonald.

Rejection of Claim 64 by Frank are Obviated by the Amendments to the Claim.

5. Claim 64 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,291,004 to Frank, *et al.* ("Frank"). This rejection is respectfully obviated with respect to the claims as currently presented.

6. Claim 64 as currently presented recites a method of "putting a dispensing apparatus at a first location in a ready state based on said identification information" and "entering destination information about a second location where at least one serving is to be delivered to a customer, *wherein the second location is a different location than the first location in said readied dispensing apparatus.*" (See Applicant's claim 64, emphasis added). As previously agreed to with the Examiner during the Examiner Interview of March 28, 2006, Frank neither teaches nor suggests the claim feature of "entering destination information about a location of a recipient where at least one serving is to be delivered in said readied dispensing apparatus [at the first location]." However, the Final Office Action has provided no reasons for the reversal of this previous agreement. Furthermore, the Final Office Action does not and cannot to cite any portion of Frank for teaching "entering destination information about a second location where at least one serving is to be delivered to a customer, wherein the second location is a different location than the first location in said readied dispensing apparatus [at the first location]" as claimed by Claim 64. Therefore, Claim 64 is patentable over Frank.

Rejection of Claim 64 by Mogadam are Obviated by the Amendments to the Claim.

7. Claim 64 is rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,036,055 to Mogadam, *et al.* ("Mogadam"). This rejection is respectfully obviated

with respect to the claims as currently presented.

8. Claim 64 as currently presented recites a method of “putting a dispensing apparatus at a first location in a ready state based on said identification information” and “entering destination information about a second location where at least one serving is to be delivered to a customer, *wherein the second location is a different location than the first location in said readied dispensing apparatus.*” (See Applicant’s claim 64, emphasis added). As previously agreed to with the Examiner during the Examiner Interview of March 28, 2006, Mogadam neither teaches nor suggests the claim feature of “entering destination information about a location of a recipient where at least one serving is to be delivered in said readied dispensing apparatus [at the first location].” However, the Final Office Action has provided no reasons for the reversal of this previous agreement. Furthermore, the Final Office Action has not and cannot to cite any portion of Mogadam for teaching “entering destination information about a second location where at least one serving is to be delivered to a customer, wherein the second location is a different location than the first location in said readied dispensing apparatus [at the first location]” as claimed by Claim 64. Therefore, Claim 64 is patentable over Mogadam.

Rejection of Claims 1, 2, 4-8, 28 and 63 by Bustos is Obviated by the Amendments to the Claims.

9. Claims 1, 2, 4-8, 28 and 63 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,164,491 to Bustos, *et al.* (“Bustos”). This rejection is respectfully obviated with respect to the claims as currently presented.

10. Claim 1 as currently presented recites a method of “putting a dispensing apparatus at a first location in a ready state based on said identification information,” and “entering destination information about a second location where at least one serving is to be delivered to a customer, *wherein the second location is a different location than the first location in said readied dispensing apparatus.*” (See Applicant’s claim 1, emphasis added). The Office Action has not and cannot cite any portion of Bustos for teaching the claimed feature of destination information including a customer location that is different

than the location of the dispensing apparatus. Bustos clearly shows, and in fact, only shows that each that the products are dispensed directly to customers via a pneumatic transfer device. (*See* Bustos, Col. 2, line 49-55). Therefore, Bustos is unable to teach every element of Independent Claims 1 as required under Section 102(e). Therefore, Independent Claims 1 as currently presented is patentable over Bustos.

11. Dependent Claims 2, 4-8, 28 and 63 depend directly or indirectly from Claim 1, and, accordingly, include all of the patentable features of Claim 1 as well as other patentable features. Therefore, Dependent Claims 2, 4-8, 28 and 63 are patentable over Bustos for at least the reasons discussed above with respect to Claim 1.

12. Applicant notes that the Final Office Action also references US Patent No. 6,604,019. The '019 patent is not discussed or part of any rejection in the Final Office Action, even though the '019 patent is cited on the attached PTO-892 form. Therefore, Applicant assumes the '019 patent to be part of the prior art made of record and not relied upon. (*See* Office Action, page. 13, para. 17).

Rejection of Claims 1, 2, 4-8, 10, 22-28 and 63 by McHale are Obviated by the Amendments to the Claims.

13. Claims 1, 2, 4-8, 28 and 63 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,913,454 to McHale ("McHale"). This rejection is respectfully obviated with respect to the claims as currently presented.

14. Claim 1 as currently presented recites a method of "putting a dispensing apparatus at a first location in a ready state based on said identification information," and "entering destination information about a second location where at least one serving is to be delivered to a customer, *wherein the second location is a different location than the first location in said readied dispensing apparatus.*" (*See* Applicant's claim 1, emphasis added). The Office Action has not and cannot cite any portion of McHale for teaching the claimed feature of destination information including a customer location that is different than the location of the dispensing apparatus. McHale clearly shows, and in fact, only

shows that each dispensing console (12, 14, 18, 20 and 24) is at the *same* location as a corresponding customer (table) location (12, 14, 18, 20 and 24, respectively) (*See McHale*, Col. 2, lines 24-29 and Fig. 1). Therefore, McHale is unable to teach every element of Independent Claims 42 and 67 as required under Section 102(b). Therefore, Independent Claims 42 and 67 as currently presented, are patentable over McHale.

15. Dependent Claims 2, 4-8, 28 and 63 depend directly or indirectly from Claim 1, and, accordingly, include all of the patentable features of Claim 1 as well as other patentable features. Therefore, Dependent Claims 2, 4-8, 28 and 63 are patentable over McHale for at least the reasons discussed above with respect to Claim 1.

Rejection of Claims 1, 2, 4, 5, 8, 9, 13, and 15-20 by Greenwald are Obviated by the Amendments to the Claims.

16. Claims 1, 2, 4, 5, 8, 9, 13, and 15-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Publication No. 2002/0198624 to Greenwald *et al.* (“Greenwald”). This rejection is respectfully obviated with respect to the claims as currently presented.

17. Claim 1 as currently presented recites a method of “putting a dispensing apparatus at a first location in a ready state based on said identification information,” and “entering destination information about a second location where at least one serving is to be delivered to a customer, *wherein the second location is a different location than the first location in said readied dispensing apparatus.*” (*See* Applicant’s claim 1, emphasis added). The Office Action has not and cannot cite any portion of Greenwald for teaching the claimed feature of destination information including a customer location that is different than the location of the dispensing apparatus. Greenwald clearly shows a drug dispensing system for dispensing medication into a tube labeled with bar code. (*See* Greenwald, para. 10). Therefore, Greenwald is unable to teach every element of Independent Claims 1 as required under Section 102(e). Therefore, Independent Claims 1 as currently presented, is patentable over Greenwald.

18. Dependent Claims 2, 4, 5, 8, 9, 13, and 15-20 depend directly or indirectly from Claim 1, and, accordingly, include all of the patentable features of Claim 1 as well as other patentable features. Therefore, Dependent Claims 2, 4, 5, 8, 9, 13, and 15-20 are patentable over Greenwald for at least the reasons discussed above with respect to Claim 1.

Rejection of Claims 1, 2, 4, 7, 12, 16-20, 23-25, 28 and 63 by Barrett are Obviated by the Amendments to the Claims.

19. Claims 1, 2, 4, 7, 12, 16-20, 23-25, 28 and 63 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,175,779 to Barrett *et al.* (“Barrett”). This rejection is respectfully obviated with respect to the claims as currently presented.

20. Claim 1 as currently presented recites a method of “putting a dispensing apparatus at a first location in a ready state based on said identification information,” and “entering destination information about a second location where at least one serving is to be delivered to a customer, wherein the second location is a different location than the first location in said readied dispensing apparatus [at the first location].” (*See* Applicant’s claim 1, emphasis added). The Office Action has not and cannot cite any portion of Barrett for teaching the claimed feature of destination information including a customer location that is different than the location of the dispensing apparatus. Barrett clearly shows a dispensing cart that dispenses medication at a patient’s bedside. (*See* Barrett, Col. 2, lines 57-62). Therefore, Barrett is unable to teach every element of Independent Claims 1 as required under Section 102(e). Therefore, Independent Claims 1 as currently presented, is patentable over Barrett.

21. Dependent Claims 2, 4, 7, 12, 16-20, 23-25, 28 and 63 depend directly or indirectly from Claim 1, and, accordingly, include all of the patentable features of Claim 1 as well as other patentable features. Therefore, Dependent Claims 2, 4, 7, 12, 16-20, 23-25, 28 and 63 are patentable over Barrett for at least the reasons discussed above with respect to Claim 1.

C. **Obviousness Rejections**

4. **Rejection of Claims 1, 2, 4-8, 10, 14, 16-20, 22, 23, 25, 27, 28, 63 and 64 by Frank in view of McHale are Obviated by the Amendments to the Claims.**

21. Claims 1, 2, 4-8, 10, 14, 16-20, 22, 23, 25, 27, 28, 63 and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Frank in view of McHale. This rejection is respectfully obviated with respect to the claims as currently presented, and lacks a proper motivation to combine the references.

22. Claim 1 as currently presented recites a method of “putting a dispensing apparatus at a first location in a ready state based on said identification information,” and “entering destination information about a second location where at least one serving is to be delivered to a customer, wherein the second location is a different location than the first location in said readied dispensing apparatus [at the first location].” (See Applicant’s claim 1, emphasis added). Claim 64 as currently presented recites a method of “entering destination information about a second location where at least one serving is to be delivered to a customer, *wherein the second location is a different location than the first location in said readied dispensing apparatus* [at the first location].” (See Applicant’s claim 64, emphasis added). The Office Action has not and cannot cite any portion of Frank for teaching the claimed feature of destination information including a customer location that is different than the location of the dispensing apparatus. Frank clearly shows, and in fact, only shows a self-serving beverage dispenser. (See Frank, FIG. 1). The location of the customer is not entered as destination information in Frank. Therefore, Frank is unable to teach every element of Independent Claims 1 and 64 as required under Section 103(a). Therefore, Independent Claims 1 and 64 as currently presented, are patentable over Frank.

23. For reasons discussed above in paragraph 14, McHale also does not teach or suggest this feature. Therefore the combination of Frank with McHale cannot teach or suggest this feature.

24. Dependant Claims 2, 4-8, 10, 14, 16-20, 22, 23, 25, 27, 28, and 63 depend directly

or indirectly on Claim 1, and, accordingly, include all of the patentable features of Claim 1 as well as other patentable features. Therefore, Dependent Claims 2, 4-8, 10, 14, 16-20, 22, 23, 25, 27, 28, and 63 are patentable over Frank in view of McHale for at least the reasons discussed above with respect to Claim 1.

25. This rejection is also *prima facie* improper, because the Final Office Action provides no proper basis for combining Frank and McHale. As set forth in MPEP § 706.02(j), “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, *there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The *teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure*. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143- §2143.03 for decisions pertinent to each of these criteria.” (See MPEP § 706.02(j); emphasis added). For at least the following reasons, the Final Office Action has erroneously failed to comply with the above requirements of MPEP § 706.02(j).

a. **This rejection provides no proper motivation for combining Frank and McHale.**

26. As stated by the Federal Circuit in *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000), “[d]etermining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness” (citing *Tec Air, Inc. v. Denso Mfg.*, 52 USPQ2d 1296, 1297-98 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with another)). Furthermore, as held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the

claimed invention, would have selected these components for combination in the manner claimed.”).

27. The Office Action attempts to justify combining Frank and McHale based on the following allegation:

(1) It would have been obvious at the time of the invention for Frank et al. to dispense premised upon the location of the customer because central distribution of the beverages reduces time in transporting beverages to the customer as taught by McHale. (*See* Office Action, page 9, para. 12).

Allegation (1) is completely unsupported by any factual evidence provided by the Final Office Action. In addition, and contrary to controlling Federal Circuit precedent (see Federal Circuit cases cited above), Allegation (1) fails to identify any portion of that Frank would properly provide a person of ordinary skill in the art reading Frank with motivation to look for McHale. The Final Office Action also fails to cite any text from McHale or Frank, or any other reference that shows that a person of ordinary skill in the art would be motivated to combine McHale or Frank. In fact, the Final Office Action has failed to even address the issue of “motivation” with respect to the combination of Frank and McHale. Because the Final Office Action has failed to provide a proper motivation for combining Frank and McHale, the rejection of Independent Claims 1 and 64 over Frank in view of McHale is *prima facie* improper.

b. Rejection of Claims 1, 2, 4-8, 10, 14, 16-20, 22, 23, 25, 27, 28, 63 and 64 over Frank in view of McHale is based on an improper hindsight use of Applicant’s own disclosure.

28. The alleged basis for combining Frank and McHale set forth in the Final Office Action in Allegation (1), quoted above, presupposes the combination of Frank and McHale, and then provides a hindsight justification for this combination. But for reading Applicant’s application, a person of ordinary skill in the art would have no reason to combine Frank and McHale. Such reliance on Applicant’s application to combine the cited references is impermissible according to controlling Federal Circuit precedent. As the Federal Circuit stated in *Cardiac Pacemakers Inc. v. St Jude Medical Inc.* 72 USPQ2d

1333, 1336 (Fed. Cir 2004) that “prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-79 (Fed. Cir. 1997) (“However, the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination.”).” Therefore, based on controlling Federal Circuit precedent, the rejection of Independent Claims 1 and 64 over Frank in view of McHale is *prima facie* improper, because the rejection is based on improper hindsight.

Rejection of Claims 1, 2, 4-8, 11, 12, 15-20, 22-28, 63 and 64 by Mogadam in view of McHale are Obviated by the Amendments to the Claims.

29. Claims 1, 2, 4-8, 11, 12, 15-20, 22-28, 63 and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mogadam in view of McHale. This rejection is respectfully obviated with respect to the claims as currently presented, and lacks a proper motivation to combine the references.

30. Claim 1 as currently presented recites a method of “putting a dispensing apparatus at a first location in a ready state based on said identification information,” and “entering destination information about a second location where at least one serving is to be delivered to a customer, wherein the second location is a different location than the first location in said readied dispensing apparatus [at the first location].” (See Applicant’s claim 1, emphasis added). Claim 64 as currently presented recites a method of “entering destination information about a second location where at least one serving is to be delivered to a customer, *wherein the second location is a different location than the first location in said readied dispensing apparatus* [at the first location].” (See Applicant’s claim 64, emphasis added). The Office Action has not and cannot cite any portion of Mogadam for teaching the claimed feature of destination information including a customer location that is different than the location of the dispensing apparatus. Mogadam clearly shows, and in fact, only shows a control device for the opening of a beverage dispenser.

(See Mogadam, Col. 3, lines 45-50). The location of the customer is not entered as destination information in Mogadam. Therefore, Mogadam is unable to teach every element of Independent Claims 1 and 64 as required under Section 103(a). Therefore, Independent Claims 1 and 64 as currently presented are patentable over Mogadam.

31. For reasons discussed above in paragraph 14, McHale also does not teach or suggest this feature. Therefore the combination of Mogadam with McHale cannot teach or suggest this feature.

32. Dependant Claims 2, 4-8, 11, 12, 15-20, 22-28 and 63 depend directly or indirectly on Claim 1, and, accordingly, include all of the patentable features of Claim 1 as well as other patentable features. Therefore, Dependent Claims 2, 4-8, 11, 12, 15-20, 22-28 and 63 are patentable over Mogadam in view of McHale for at least the reasons discussed above with respect to Claim 1.

33. This rejection is also *prima facie* improper, because the Final Office Action provides no proper basis for combining Mogadam and McHale as required by Section 706.02(j), as discussed above in paragraph 25.

34. As stated by the Federal Circuit in *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000), “[d]etermining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness” (citing *Tec Air, Inc. v. Denso Mfg.*, 52 USPQ2d 1296, 1297-98 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with another)). Furthermore, as held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”)).

35. The Office Action attempts to justify combining McHale and Mogadam based on the following allegation:

(2) It would have been obvious at the time of the invention for Mogadam et al. to dispense premised upon the location of the customer because central distribution of the beverages reduces time in transporting beverages to the customer as taught by McHale. (*See* Office Action, page 11, para. 13).

Allegation (2) is completely unsupported by any factual evidence provided by the Final Office Action. In addition, and contrary to controlling Federal Circuit precedent (see Federal Circuit cases cited above), Allegation (2) fails to identify any portion of McHale that would properly provide a person of ordinary skill in the art reading McHale with motivation to look for Mogadam. The Final Office Action also fails to cite any text from McHale or Mogadam, or any other reference that shows that a person of ordinary skill in the art would be motivated to combine McHale or Mogadam. In fact, the Final Office Action has failed to even address the issue of “motivation” with respect to the combination of McHale and Mogadam. Because the Final Office Action has failed to provide a proper motivation for combining McHale and Mogadam, the rejection of Independent Claims 1 and 64 over Mogadam in view of McHale is *prima facie* improper.

36. The alleged basis for combining McHale and Mogadam set forth in the Final Office Action in Allegation (2), quoted above, presupposes the combination of McHale and Mogadam, and then provides a hindsight justification for this combination. But for reading Applicant’s application, a person of ordinary skill in the art would have no reason to combine McHale and Mogadam. Such reliance on Applicant’s application to combine the cited references is impermissible according to controlling Federal Circuit precedent. As the Federal Circuit stated in *Cardiac Pacemakers Inc. v. St Jude Medical Inc.* 72 USPQ2d 1333, 1336 (Fed. Cir 2004) that “prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-79 (Fed. Cir. 1997) (“However, the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination.”).” Therefore, based

on controlling Federal Circuit precedent, the rejection of Independent Claims 1 and 64 over Mogadam in view of McHale is *prima facie* improper, because the rejection is based on improper hindsight.

Rejection of Claims 1, 2, 4-10, 13, 22-28 and 63 by McHale in view of Peckels are Obviated by the Amendments to the Claims.

37. Claims 1, 2, 4-10, 13, 22-28 and 63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over McHale in view of US Patent No. 5,255,819 to Peckels ("Peckels"). This rejection is respectfully obviated with respect to the claims as currently presented, and lacks a proper motivation to combine the references.

38. Claim 1 as currently presented recites a method of "putting a dispensing apparatus at a first location in a ready state based on said identification information," and "entering destination information about a second location where at least one serving is to be delivered to a customer, wherein the second location is a different location than the first location in said readied dispensing apparatus [at the first location]." (*See Applicant's claim 1, emphasis added*). For reasons discussed above in paragraph 14, McHale also does not teach or suggest this feature. The Office Action has not and cannot cite any portion of Peckels for teaching the claimed feature of destination information including a customer location that is different than the location of the dispensing apparatus. Peckels clearly shows, and in fact, only shows a control device for the opening of a beverage dispenser. (*See Peckels, Col. 4, lines 13-17*). The location of the customer is not entered as destination information in Peckels. Therefore, Peckels is unable to teach every element of Independent Claims 1 as required under Section 103(a) and the combination of McHale in view of Peckels cannot teach or suggest this feature. Therefore, Independent Claims 1 currently presented is patentable over McHale in view of Peckels.

39. Dependant Claims 2, 4-10, 13, 22-28 and 63 depend directly or indirectly on Claim 1, and, accordingly, include all of the patentable features of Claim 1 as well as other patentable features. Therefore, Dependent Claims 2, 4-10, 13, 22-28 and 63 are patentable over McHale in view of Peckels for at least the reasons discussed above with respect to

Claim 1.

40. This rejection is also *prima facie* improper, because the Final Office Action provides no proper basis for combining McHale in view of Peckels as required by Section 706.02(j), as discussed above in paragraph 25.

41. As stated by the Federal Circuit in *Sibia Neurosciences Inc. v. Cadus Pharmaceutical Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000), “[d]etermining whether there is a suggestion or motivation to modify a prior art reference is one aspect of determining the scope and content of the prior art, a fact question subsidiary to the ultimate conclusion of obviousness” (citing *Tec Air, Inc. v. Denso Mfg.*, 52 USPQ2d 1296, 1297-98 (Fed. Cir. 1999) (stating that the factual underpinnings of obviousness include whether a reference provides a motivation to combine its teachings with another)). Furthermore, as held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”)).

42. The Office Action attempts to justify combining McHale in view of Peckels based on the following allegations:

(3) It would have been obvious for McHale to identify the dispense with bar codes because a scanner can reduce the incidence of entry error as taught by Peckels. (See Office Action, page 12, para. 14).

Allegation (3) is completely unsupported by any factual evidence provided by the Final Office Action. In addition, and contrary to controlling Federal Circuit precedent (see Federal Circuit cases cited above), Allegation (3) fails to identify any portion of McHale that would properly provide a person of ordinary skill in the art reading McHale with motivation to look for Peckels. The Final Office Action also fails to cite any text from McHale or Peckels, or any other reference that show that a person of ordinary skill in the art would be motivated to combine McHale or Peckels. In fact, the Final Office Action has

failed to even address the issue of “motivation” with respect to the combination of McHale and Peckels. Because the Final Office Action has failed to provide a proper motivation for combining McHale and Peckels, the rejection of Independent Claims 1 over McHale in view of Peckels is *prima facie* improper.

43. The alleged basis for combining McHale and Peckels set forth in the Final Office Action in the allegations, quoted above, presupposes the combination of McHale and Peckels, and then provides a hindsight justification for this combination. But for reading Applicant’s application, a person of ordinary skill in the art would have no reason to combine McHale and Peckels. Such reliance on Applicant’s application to combine the cited references is impermissible according to controlling Federal Circuit precedent. As the Federal Circuit stated in *Cardiac Pacemakers Inc. v. St Jude Medical Inc.* 72 USPQ2d 1333, 1336 (Fed. Cir 2004) that “prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1578-79 (Fed. Cir. 1997) (“However, the record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination.”).” Therefore, based on controlling Federal Circuit precedent, the rejection of Independent Claims 1 over McHale and Peckels is *prima facie* improper, because the rejection is based on improper hindsight.

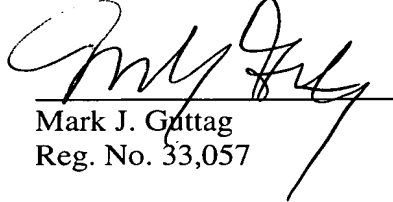
D. Request for Affidavit under 37 C.F.R. § 1.104(d)(2).

44. In addition, with respect to Claims 1, 2, 4, 6-20, 22-28, 63 and 64, these claims have been rejected on the basis of facts within the personal knowledge of the Examiner. As discussed above, Allegations (1), (2) and (3) are unsupported by any factual evidence provided by the Examiner. Accordingly, under 37 C.F.R. § 1.104(d)(2) the Applicants hereby request that the Examiner provide an affidavit supporting the Examiner’s assertion used as a basis for this rejection, or, in the alternative, to withdraw the rejection of Claims 1, 2, 4, 6-20, 22-28, 63 and 64.

E. Conclusion.

45. In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,



Mark J. Gutttag
Reg. No. 33,057

JAGTIANI + GUTTAG
Democracy Square Business Center
10363-A Democracy Lane
Fairfax, Virginia 22030
703-591-2664

September 18, 2006